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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,844	03/04/2002	Walter Navarrini	108910-00056	4312

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EXAMINER
ZITOMER, FRED

ART UNIT	PAPER NUMBER
1713	11

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No. 10/086,844	Applicant(s) NAVARRINI ET AL.	
	Examiner Fred Zitomer	Art Unit 1713	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 February 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) *1 and 5* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-4 and 6-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3,4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1.

Applicant's election with traverse of Group II, claims 2-8, and the elected species of polymerization process in Paper Nos. 8 and 10 are acknowledged. The traversal is on the ground that it would not be a serious burden to search Groups I and II together. This is not found persuasive because Groups I and II respectively relate to initiator compounds and methods of polymerizing fluorinated monomers. The two inventions are distinct and require different searches and the consideration of different issues to assure a complete and thorough examination.

The requirement is still deemed proper and is therefore made FINAL.

Contrary to applicant's assertion claim 5 does not read on the elected species. Accordingly, claims 2-4 and 6-8 are being examined at this time.

2.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2,3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Noda et al., EP 0 606 492.

Noda teaches polymerizing fluorinated monomers in the presence of difluoroacyl peroxide initiators [page 2, line 23 et seq.]. Continuous or batch polymerization [page 4, lines 8-13] in aqueous media [page 3, lines 40-44] and the claimed amounts of initiator [page 3, lines 18-24] are disclosed. While the polymerization temperature of instant claim 4 is not disclosed

the reference clearly suggests that said temperature is a result effective variable to be determined according to the need at hand [page 3, line 46 – 58]. The embodiment is therefore deemed obvious and not to impact patentability. MPEP 2144.05, II A, B. Difluoroacyl peroxide initiators within a general formula encompassing instant formula (A) are disclosed [page 2, lines 23-39; claim 1]. The disclosures of Noda are commensurate with the instant invention.

3.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Noda et al., EP 0 606 492.

Noda teaches polymerizing fluorinated monomers in the presence of difluoroacyl peroxide initiators as noted above. The peroxide of instant claim 4 is within the general formula for peroxides set forth at page 2, line 30. When "m" and "n" are 3 in said formula and "X^1" and "X^2" are F only two isomers, one of which is the isomer of instant claim 4, are possible. In this regard it is well settled that when the reference teaches a small genus which places a claimed species in the possession of the public the burden is on applicant to show that the species is either different or unobvious in view of the reference. *In re Schaumann, 572 F. 2d 312, 197*

USPQ 5 (CCPA 1978). Accordingly, the claimed invention is anticipated by or obvious over the disclosures of Noda and the burden is on applicant to show otherwise.

4.

Claims 2-4 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura et al., US 4,910,276, hereinafter Nakamura `276.

Nakamura `276 teaches polymerizing fluorinated monomers [paragraph bridging columns 5 and 6; claims 11 and 12] by aqueous emulsion or suspension polymerization [column 5, lines 27-33] at temperatures of 0 to 200°C. [column 5, lines 39-43] in the presence of the perfluorodiacylperoxide initiator and amounts thereof of present claim 4 [see e.g. Examples 3-6,10-15,17 and 18]. The disclosures of Nakamura `276 are commensurate with the instant invention.

5.

The following rejection is based on an in-house search which indicates that double patenting with a copending application may be at issue. Unfortunately said application was not available at the time of the present Office action and applicant is requested to reply as explained below. Attempts are being made to obtain the copending action.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-4 and 6-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending Application No. 10/128,411. Although the conflicting claims are not identical, they are not patentably distinct from each other because the STN abstract and title suggest that the copending application relates to the process of using the present perfluorodiacylperoxides in aqueous radical polymerizations. Because the copending application is not available to the examiner at this time the burden is on applicant to show that an improper timewise extension of the right to exclude is not at issue. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakamura et al., US 4,897,457, is being cited cumulative to Nakamura '276.

7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Zitomer whose telephone number is (703) 308-2461. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful David Wu can be reached at (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 (before final) and (703) 872-9311 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

FRED ZITOMER, PhD
PRIMARY EXAMINER
ART UNIT 1713

Zitomer/fz
May 1, 2003